

PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 1797**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Reiji MATSUBARA et al.

Group Art Unit: 1797

Application No.: 10/549,758

Examiner: A. ORLANDO

Filed: October 6, 2006

Docket No.: 125362

For: HONEYCOMB STRUCTURE

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Claims 1-12 are pending. The period for reply has been extended by the attached Petition for Extension of Time. In reply to the December 4, 2008 Office Action, reconsideration and prompt allowance of the pending claims are respectfully requested in light of the following remarks.

The courtesies extended to Applicants' representatives by Examiner Orlando and Supervisory Examiner Griffin at the March 12, 2009 interview, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below, which constitute Applicants' record of the interview.

Claims 1-5 and 7-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over WO 03/011427 (Hamanaka) in view of WO 2002/079618 (Hijikata). Applicants respectfully traverse the rejection.

In particular, the references fail to disclose, teach, or suggest "a segment part including a plurality of first honeycomb segments bonded together by a bonding material," as recited in claim 1. Hamanaka discloses a honeycomb structural body (Abstract). The Office Action admits that Hamanaka fails to disclose the claimed feature of "a segment part including a plurality of first honeycomb segments bonded together by a bonding material," (the Office Action at page 4, lines 4-5).

The Office Action asserts that column 4, lines 49-52 of Hijikata discloses segments being separated by a bonding material (the Office Action at page 4, lines 6-7). The Office Action further asserts that one of ordinary skill would have been motivated to combine Hamanaka and Hijikata to render obvious the subject matter recited in claim 1. Applicants respectfully traverse this assertion for the following three reasons.

First, the Office Action asserts that, taken collectively, the Hamanaka and Hijikata references disclose Applicants' invention (the Office Action page 7, lines 1-3). This assertion is improper since Hamanaka explicitly excludes bond layer, and thus teaches away from the claimed invention. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." (MPEP §2141.02(VI)). Hamanaka discloses that "the flow channel separator in the present application is different from a bond layer formed for bonding a segmented/divided honeycomb structure, and the bond layer is excluded from the flow channel separator of the present application" (paragraph [0030], emphasis added). Thus, Hamanaka explicitly teaches that the bond layer cannot be used as the flow channel separator. Accordingly, one of ordinary skill would not have had any reason to replace Hamanaka's flow channel separator with a bond layer.

Second, the asserted combination of Hamanaka and Hijikata would render Hamanaka's invention unsatisfactory for its intended purpose. The object of Hamanaka is "to provide a honeycomb structure which is not segmented or is integrally constituted of a

smaller number of segments to suppress a local temperature rise and to reduce damages by the thermal stress" (paragraph [0006], emphasis added). Hamanaka also discloses that "[s]ince this effect is obtained by the flow channel separator, it is possible to reduce breakage by thermal stress without dividing the honeycomb structure into segments or with a smaller number of division...." (paragraph [0030], emphasis added). Thus, the flow channel separator is an essential element of Hamanaka and if the flow channel separator of Hamanaka is replaced by the bonding layer as asserted by the Office Action, Hamanaka would not be able to achieve its intended purpose. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (MPEP §2143.01(V)). Thus, there is no motivation to make the proposed modification in the asserted combination of references.

In this regard, the Office Action asserts that "the flow channel separator of the Hamanaka reference does not allow the flow of air to pass through, which the bonding material of the Hijikata reference also does not allow" (the Office Action at page 7, lines 1-6). However, this assertion is irrelevant. The asserted similarity between a flow channel separator and a bond layer does not negate the requirement in Hamanaka that the flow channel separator cannot be replaced by a bond layer. Thus, the asserted similarity does not provide a motivation to negate the exclusion of the bond layer required in Hamanaka.

Thus, it would not have been obvious to one of ordinary skill to have combined Hamanaka and Hijikata to arrive at the subject matter recited in claim 1.

Third, the Office Action asserts that column 4, lines 49-52, of Hijikata discloses segments being separated by a bonding material. However, column 4, lines 49-52, of Hijikata only discloses that the material A having compressive elasticity is preferred to have heat resistance and cushioning, and does not disclose the bonding material. Thus, column 4, lines 49-52 of Hijikata does not disclose the asserted feature.

Accordingly, claim 1 is patentable over Hamanaka and Hijikata. Further claims 2-5 and 7-11 are patentable for at least the same reasons, as well as for the additional features each recites. Applicants respectfully request withdrawal of the rejection.

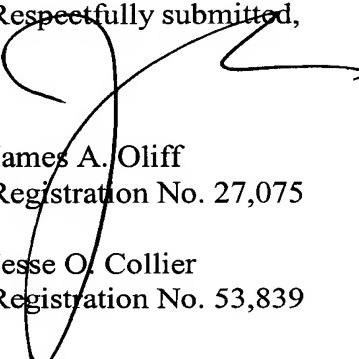
Claims 6 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hamanaka in view of Hijikata and further in view of WO 03/021089 (Kondo). Applicants respectfully traverse the rejection.

This rejection is premised upon the presumption that one of ordinary skill would have been motivated to combine Hamanaka and Hijikata as alleged by the Office Action. As discussed above, it would not have been obvious to one of ordinary skill to have combined Hamanaka and Hijikata to arrive at the subject matter recited in claim 1. Kondo fails to make up for the deficiency of Hamanaka and Hijikata. Thus, claims 6 and 12 are also patentable for at least the same reasons as discussed above, as well as for the additional features each recites. Applicants respectfully request withdrawal of the rejection.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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Attachment:

Petition for Extension of Time

Date: March 26, 2009

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